

**REMARKS**

Claims 1, 4, 5, 7, 12-15, 18, 19, 21, 24, 25, 27, 30, 31, 36, 37, and 39 are pending in this application, with claims 2, 3, 6, 16, 17, 20, 22, 23, 26, 28, 29, 32-35, and 38 being cancelled by this Amendment. Claims 1-7 and 12-39 currently stand rejected, and claims 1, 4, 5, 7, 12-15, 18, 19, 21, 24, 25, 27, 30, 31, 36, 37, and 39 have been amended. Reconsideration and allowance of the present application are respectfully requested in light of the preceding amendments and following remarks.

**Entry of Amendments**

Applicants respectfully request entry of the preceding amendments following the closing of prosecution in connection with the present application. The amendments to each independent claim merely incorporate subject matter previously presented in now cancelled dependent claims. For example, claim 1 has been amended to recite “mark information [that] includes at least one mark associated with the second still image” as previously presented in dependent claim 2; “identification information indentifying a playitem on which the at least one mark is placed” as previously presented in dependent claim 3, depending from claim 2; and “number information indicating the total number of marks” as previously presented in claim 6, also depending from claim 2. The amendments to the claims thus do not change their previous scope or require any additional search. Further, each of the “mark information,” “identification information,” and “number information” are discussed below, individually, as

missing from the applied references. As such, the amendments further place the claims either in condition for allowance or in better form for appeal, by consolidating the unique and argued features into the independent claims. Entry of amendments cancelling claims, presenting the claims in clearer form for appeal, and including only subject matter earlier presented are specifically permissible under 37 C.F.R. § 1.116(b)(1)-(3), and Applicants respectfully request entry of the same.

Rejection under 35 U.S.C. §103

Claims 1-7 and 12-39 stand rejected under 35 U.S.C. §103(a) as being anticipated by US Pat 6,385,389 to Maruyama et al. ("Maruyama") in view of US Pat Pub 2002/0110369 to Mori et al. Applicants respectfully traverse this rejection for the reasons detailed below.

With regard to claim 1, Applicants initially note that the claim has been amended to recite "mark information [that] includes at least one mark associated with the second still image," "identification information indentifying a playitem on which the at least one mark is placed," and "number information indicating the total number of marks." Applicants note that this subject matter was previously presented and rejected in now-cancelled dependent claims 3 and 6. Thus, the rejections to claims 3 and 6 are addressed with regard to claim 1.

The Examiner alleges that the navigation pack of Maruyama, in FIG. 12, discloses a navigation pack 86 including a pack header 110 that corresponds

to the recited “identification information **indentifying a playitem on which the at least one mark is placed.**” Applicants respectfully submit that the pack header 110 contains a pack start code, a system clock reference, and a multiplexing rate. See Maruyama, Col. 14, ll. 38-41. None of this information identifies the navigation pack 86 or indicates that the pack header 110 is in any particular navigation pack 86. Indeed, in the single brief paragraph where Maruyama describes information in the pack header, Maruyama suggests that each piece of information is used in MPEG2 decoding. See Maruyama, Col. 14, ll. 38-39. As such, a “pack start code” is most likely an instruction to begin decoding, and, at any rate, does not necessarily meet or suggest identification information having the recited functionality.

The Examiner further alleges that Maruyama discloses mark information “**indicating a number of marks**” in FIG. 27 by pack sector numbers in the VOBUs. Applicants respectfully submit that the pack sectors in FIG. 27 are merely physical addresses and that each VOBUs may have a variable number of associated sectors, depending on the VOBUs size, such as sectors 1431-1432 associated with single VOBUs 1411. See Maruyama, FIG. 27; Col. 35, ll. 21-25 (two sectors per VOBUs). Because there is one navigation pack per VOBUs, the sectors will not correspond to a number of navigation packs. Thus, the sector numbers, which are never stated to be stored numbers in the sectors but instead are more likely identifiers for figure description purposes, cannot indicate a number of navigation packs. Thus, Maruyama further lacks the recited number information.

Because Maruyama fails to disclose each and every element of claim 1 as amended (or now-cancelled claims 3 or 6 as previously presented), Maruyama cannot anticipate or render obvious claim 1. Claims 12-15 recite the same unique feature as amended claim 1 discussed above and are thus equally allowable over Maruyama. Claims 4, 5, 7, 18, 19, 21, 24, 25, 27, 30, 31, 36, 37, and 39 are allowable at least for depending from a valid base claim. Withdrawal of the rejection under § 103(a) to claims 1, 4, 5, 7, 12-15, 18, 19, 21, 24, 25, 27, 30, 31, 36, 37, and 39 is respectfully requested.

Provisional Claim Rejections - Double Patenting

Claims 1-7 and 12-39 stood provisionally rejected under nonstatutory obviousness-type double patenting as being unpatentable over claims in co-pending Application No. 10/766,211 in view of Maruyama. Applicants note that this rejection is not repeated, incorporated, or referenced in the Office Action, indicating it has been withdrawn.

**CONCLUSION**


In view of the above remarks and amendments, Applicants respectfully submit that each of the rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By

  
\_\_\_\_\_  
Ryan Alley, Reg. No. 60,977  
Gary D. Yacura, Reg. No. 35,416  
P.O. Box 8910  
Reston, Virginia 20195  
(703) 668-8000

GDY/REA: tlt